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EXAMINER

HUTTON JR, WILLIAM D

ART UNIT PAPER NUMBER

2176

DATE MAILED: 09/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/044,922

Applicant(s)

GOODWIN ET AL.

Examiner

Doug Hutton

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) 2-8, 17-23, 32-38 and 47-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 9-16, 24-31, 39-46 and 54-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's Response

In Applicant's Response dated 11 July 2005, Applicant elected Species 2 and traversed the restriction.

Election/Restrictions

In the Office Action dated 9 June 2005, the examiner declared that the application contains claims directed to the following patentably distinct species of the claimed invention: Species 1 (see Figures 2 and 4); and Species 2 (see Figure 1, Steps 110-114). The examiner stated that Claims 1, 16, 31, and 46 are generic to Species 1 and 2.

Applicant responded by electing **Species 2**. Applicant also observed that "*the claims that appear to correspond to Specie [sic] 1 (i.e., claims 2, 3, 4, 6) are dependent from the generic independent claims that correspond to Specie [sic] 2*" and argued that "*this restriction appears improper at least because the claims for Specie [sic] 1 are not 'independent and distinct' from the claims that correspond to Specie [sic] 2.*"

The examiner disagrees that the election of species requirement was improper. The ***independent*** claims are generic and correspond to both species. Upon allowance of a generic claim, Applicant will be entitled to consideration of claims to additional

species which are written in dependent form or otherwise include all the limitations of an allowed generic claim.

It is the ***dependent*** claims that define the "independent and distinct" species. Applicant acknowledges this by observing that Claims 2, 3, 4 and 6 correspond to Species 1. Stated differently, the limitations of Claims 2, 3, 4 and 6 distinguish Species 1 from Species 2. That is, Claims 2-8 (Species 1) patentably distinguishable from Claims 9-13 (Species 2).

The requirement of an election of species is still deemed proper and is therefore made FINAL.

Applicant failed to submit an express listing of all claims readable on Species 2, so the examiner will do so. Claims 9-13, 24-28, 39-43, 54-58 read on Species 2. Additionally, Claims 14, 15, 29, 30, 44, 45, 59 and 60 are generic to both species and thus read on Species 2.

Claims 2-8, 17-23, 32-38 and 47-53 read on Species 1 and are thus withdrawn from consideration.

Specification

The abstract of the disclosure is objected to because it exceeds 150 words in length. Correction is required. See MPEP § 608.01(b).

The disclosure is objected to because of the following informalities:

- the paragraphs under the heading "*RELATED APPLICATIONS*" should be updated so that the patent numbers for the referenced applications are indicated. That is, some of the referenced applications are now patents and the information should thus be updated;
- the term "*link*" on Page 7, Line 22 should be amended to – links – so that the sentence is grammatically correct; and
- the term "*infinity*" on page 8, Line 2 should be amended to – affinity – because it appears to be a typographic error.

Appropriate correction is required.

Claim Objections

Claims 12, 27, 42 and 57 are objected to because of the following informalities:

- in Claim 12, the term "a" should be inserted between the terms "*per*" and "*predetermined*" in Line 2 so that the sentence is grammatically correct; Claims 27, 42 and 57 have the same problem.

Claim 35 is objected to because of the following informalities:

- the term "*associating*" in Line 2 should be amended to – associates – so that the sentence is grammatically correct.

Claims 44 and 45 are objected to because of the following informalities:

- the term “*enabling*” in Line 1 should be amended to – enables – so that the sentence is grammatically correct.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 9-16, 24-31, 39-46 and 54-60 are rejected under 35 U.S.C. 101

because the claimed invention is directed to non-statutory subject matter.

Claims 1 and 9-15:

The language of the claims raise a question as to whether the claims are directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

Additionally, the claimed invention is so abstract and sweeping that it covers the method as practiced by a human operator assisted only by pencil and paper. The claims do not include a particular machine or apparatus, and no machine-implemented steps are recited. Every step is capable of performance by the human mind. A method of this sort, traditionally called a “mental process,” is not patentable subject matter.

“Phenomena of nature, though just discovered, “*mental processes*,” abstract intellectual concepts are not patentable as they are the basic tools of scientific and technological work.” (emphasis added) *Gottschalk v. Benson*, 75 U.S.P.Q. 673, 675 (U.S.S.C. 1972). See also, *In re Prater and Wei*, 159 U.S.P.Q. 583 (1968), *rehearing* U.S.P.Q. 571 (1969).

Applicant may obviate this rejection by amending the preamble of Claim 1 to — A computerized method for determining a user affinity for a topic comprising the steps of:

—.

Claims 16, 24-31, 39-46 and 54-60:

The language of the claims raise a question as to whether the claims are directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. As currently specified, the invention merely comprises computer software that is not tangibly embodied on a computer-readable medium.

Applicant may obviate this rejection by amending the preambles of Claims 16 and 31 to — A system tangibly embodied on a computer-readable medium for determining a user affinity for a topic comprising: —.

Applicant may obviate this rejection by amending the preamble of Claim 46 to — A tangible processor readable medium comprising processor readable code embodied therein for determining a user affinity for a topic, the medium comprising: —.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 9, 10, 13, 15, 16, 24, 25, 28, 30, 31, 39, 40, 43, 45, 46, 54, 55, 58 and 60 are rejected under 35 U.S.C. 102(b) as being anticipated by Vivacqua, Adriana, et al., “**Agents to Assist in Finding Help**” – Conference on Human Factors & Computing Systems Proceedings, in the Hague, the Netherlands, April, 2000, Pages 65-72.

Claim 1:

Vivacqua discloses *a method for determining a user affinity for a topic* (see Pages 65-72 – Vivacqua discloses this limitation, as indicated in the cited text) comprising the steps of:

- *assigning a category to at least one object, the at least one object comprising at least one topic* (see Pages 65-72 – Vivacqua discloses this limitation, as indicated in the cited text);
- *associating the at least one object with at least one user* (see Pages 65-72 – Vivacqua discloses this limitation, as indicated in the cited text);

- *maintaining a record of actions performed on the at least one object by the at least one user* (see Pages 65-72 – Vivacqua discloses this limitation, as indicated in the cited text);
- *determining a user affinity for the at least one topic based on at least the category and the record of actions* (see Pages 65-72 – Vivacqua discloses this limitation, as indicated in the cited text).

Claim 9:

Vivacqua discloses *the method of Claim 1, further comprising the step of:*

- *determining whether the at least one user has performed at least one action on the at least one object* (see Pages 65-72 – Vivacqua discloses this limitation, as indicated in the cited text).

Claim 10:

Vivacqua discloses the method of Claim 9, further comprising the step of:

- *decaying the user affinity of the at least one user if a determination is made that the at least one user has not performed any actions on the at least one object* (see Pages 65-72 – Vivacqua discloses this limitation, as indicated in the cited text).

Claim 13:

Vivacqua discloses *the method of Claim 9, further comprising the step of:*

- *resetting the user affinity if a determination is made that the at least one user has performed the at least one action on the at least one object (see Pages 65-72 – Vivacqua discloses this limitation, as indicated in the cited text).*

Claim 15:

Vivacqua discloses *the method of Claim 1, further comprising the step of:*

- *enabling the user to decline the user affinity (see Pages 65-72 – Vivacqua discloses this limitation, as indicated in the cited text).*

Claims 16, 24, 25, 28 and 30:

Claims 16, 24, 25, 28 and 30 merely recite a system that performs the method of Claims 1, 9, 10, 13 and 15, respectively. Vivacqua discloses a computer system. Thus, Vivacqua discloses every limitation of Claims 16, 24, 25, 28 and 30, as indicated in the above rejections for Claims 1, 9, 10, 13 and 15.

Claims 31, 39, 40, 43 and 45:

Claims 31, 39, 40, 43 and 45 merely recite a system that performs the method of Claims 1, 9, 10, 13 and 15, respectively. Vivacqua discloses a computer system. Thus, Vivacqua discloses every limitation of Claims 31, 39, 40, 43 and 45, as indicated in the above rejections for Claims 1, 9, 10, 13 and 15.

Claims 46, 54, 55, 58 and 60:

Claims 46, 54, 55, 58 and 60 merely recite computer software that performs the method of Claims 1, 9, 10, 13 and 15, respectively. Vivacqua discloses computer software. Thus, Vivacqua discloses every limitation of Claims 46, 54, 55, 58 and 60, as indicated in the above rejections for Claims 1, 9, 10, 13 and 15.

Claims 1, 9, 14-16, 24, 29-31, 39, 44-46, 54, 59 and 60 are rejected under 35 U.S.C. 102(e) as being anticipated by Newbold, U.S. Patent Application Publication No. US Patent Application Publication No. 2002/0087600.

Claim 1:

Newbold discloses a method for determining a user affinity for a topic (see Figures 1-5; see Pages 1-6 – Newbold discloses this limitation, as clearly indicated by the cited figures and text) comprising the steps of:

- assigning a category to at least one object, the at least one object comprising at least one topic (see Figures 1-5; see Pages 1-6 – Newbold discloses this limitation, as clearly indicated by the cited figures and text);
- associating the at least one object with at least one user (see Figures 1-5; see Pages 1-6 – Newbold discloses this limitation, as clearly indicated by the cited figures and text);

- maintaining a record of actions performed on the at least one object by the at least one user (see Figures 1-5; see Pages 1-6 – Newbold discloses this limitation, as clearly indicated by the cited figures and text);
- determining a user affinity for the at least one topic based on at least the category and the record of actions (see Figures 1-5; see Pages 1-6 – Newbold discloses this limitation, as clearly indicated by the cited figures and text).

Claim 9:

Newbold discloses the method of Claim 1, further comprising the step of:

- determining whether the at least one user has performed at least one action on the at least one object (see Figures 1-5; see Pages 1-6 – Newbold discloses this limitation, as clearly indicated by the cited figures and text).

Claim 14:

Newbold discloses the method of Claim 1, further comprising the step of:

- enabling a system administrator to decline the user affinity (see Figures 1-5; see Pages 1-6 – Newbold discloses this limitation, as clearly indicated by the cited figures and text).

Claim 15:

Newbold discloses the method of Claim 1, further comprising the step of:

- enabling the user to decline the user affinity (see Figures 1-5; see Pages 1-6 – Newbold discloses this limitation, as clearly indicated by the cited figures and text).

Claims 16, 24, 29 and 30:

Claims 16, 24, 29 and 30 merely recite a system that performs the method of Claims 1, 9, 14 and 15, respectively. Newbold discloses a computer system. Thus, Newbold discloses every limitation of Claims 16, 24, 29 and 30, as indicated in the above rejections for Claims 1, 9, 14 and 15.

Claims 31, 39, 44 and 45:

Claims 31, 39, 44 and 45 merely recite a system that performs the method of Claims 1, 9, 14 and 15, respectively. Newbold discloses a computer system. Thus, Newbold discloses every limitation of Claims 31, 39, 44 and 45, as indicated in the above rejections for Claims 1, 9, 14 and 15.

Claims 46, 54, 59 and 60:

Claims 46, 54, 59 and 60 merely recite computer software that performs the method of Claims 1, 9, 14 and 15, respectively. Newbold discloses computer software. Thus, Newbold discloses every limitation of Claims 46, 54, 59 and 60, as indicated in the above rejections for Claims 1, 9, 14 and 15.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14, 29, 44 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vivacqua.

Claim 14:

As indicated in the above discussion, Vivacqua discloses every limitation of Claim 1. Vivacqua also discloses enabling a user to decline the user affinity. Vivacqua also discloses a computer network comprising multiple users in a client-server setup. The client users may use *Expert Finder* to locate other users on the network that are considered to be experts in a certain area.

Vivacqua fails to expressly disclose:

- *enabling a system administrator to decline the user affinity.*

However, it was well known by one of ordinary skill in the art at the time the invention was made to allow a network administrator the capability of disallowing client user access to information on a computer network. At the time the invention was made, the network administrator controlled information on a computer network and granted access rights to the client users. The network administrator would have denied access to information on a user's profile for the purpose of protecting confidential or sensitive information in the user's profile. As previously indicated, Vivacqua already discloses

enabling a user to decline the user affinity. This same capability would likely have also belonged to the network administrator. Even though Vivacqua does not expressly disclose this feature, one of ordinary skill in the art at the time the invention was made would immediately know that this capability – declining the user affinity – could have easily been granted to the system administrator.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Vivacqua, to include:

- *enabling a system administrator to decline the user affinity,*

for the purpose of protecting confidential or sensitive information in the user's profile.

Claim 29:

Claim 29 merely recites a system that performs the method of Claim 14. Vivacqua discloses a computer system. Thus, Vivacqua discloses every limitation of Claim 29, as indicated in the above rejection for Claim 14.

Claim 44:

Claim 44 merely recites a system that performs the method of Claim 14. Vivacqua discloses a computer system. Thus, Vivacqua discloses every limitation of Claim 44, as indicated in the above rejections for Claim 14.

Claim 59:

Claim 59 merely recites computer software that performs the method of Claim 14. Vivacqua discloses computer software. Thus, Vivacqua discloses every limitation of Claim 59, as indicated in the above rejection for Claims 14.

Claims 11, 12, 26, 27, 41, 42, 56 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vivacqua, in view of Gilmour, U.S. Patent No. 6,832,224.

Claim 11:

As indicated in the above rejection, Vivacqua discloses every limitation of Claim 10.

Vivacqua fails to expressly disclose:

- *decaying the user affinity at a constant rate.*

Gilmour teaches *a method for determining a user affinity for a topic* (see Figures 1-23; see Column 1, Line 1 through Column 32, Line 44 – Gilmour teaches this limitation, as indicated in the cited figures and text), *wherein the step of decaying the user affinity decays at a constant rate* (see Column 25, Line 22 through Column 26, Line 67 – Gilmour teaches this limitation in that the knowledge management tool decays the confidence value for a term by 5% per month), for the purpose of preventing a potentially relevant term ignored or overlooked when calculating a confidence level for a user.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Vivacqua, to include the step of:

- *decaying the user affinity at a constant rate,*

for the purpose of preventing a potentially relevant term ignored or overlooked when calculating a confidence level for a user, as taught in Gilmour.

Claim 12:

Vivacqua fails to expressly disclose:

- *a constant rate that is a predetermined percentage per predetermined period of time.*

Gilmour teaches *a method for determining a user affinity for a topic* (see Figures 1-23; see Column 1, Line 1 through Column 32, Line 44 – Gilmour teaches this limitation, as indicated in the cited figures and text), *wherein the constant rate is a predetermined percentage per predetermined period of time* (see Figures 1-23; see Column 1, Line 1 through Column 32, Line 44 – Gilmour teaches this limitation, as indicated in the cited figures and text), for the purpose of preventing a potentially relevant term ignored or overlooked when calculating a confidence level for a user.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Vivacqua, to include:

- *a constant rate that is a predetermined percentage per predetermined period of time,*

for the purpose of preventing a potentially relevant term ignored or overlooked when calculating a confidence level for a user, as taught in Gilmour.

Claims 26 and 27:

Claims 26 and 27 merely recite a system that performs the method of Claims 11 and 12, respectively. Vivacqua discloses and Gilmour teaches a computer system. Thus, Vivacqua, in view of Gilmour, discloses/teaches every limitation of Claims 26 and 27, as indicated in the above rejections for Claims 11 and 12.

Claims 41 and 42:

Claims 41 and 42 merely recite a system that performs the method of Claims 11 and 12, respectively. Vivacqua discloses and Gilmour teaches a computer system. Thus, Vivacqua, in view of Gilmour, discloses/teaches every limitation of Claims 41 and 42, as indicated in the above rejections for Claims 11 and 12.

Claims 56 and 57:

Claims 56 and 57 merely recite computer software that performs the method of Claims 11 and 12, respectively. Vivacqua discloses and Gilmour teaches computer software. Thus, Vivacqua, in view of Gilmour, discloses/teaches every limitation of Claims 56 and 57, as indicated in the above rejections for Claims 11 and 12.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Goldberg et al., U.S. Patent No. 6,711,570; Goldberg, U.S. Patent No. 6,668,251; **TACIT – KnowledgeMail & KnowledgeMail Plus**, "*Creating the Smarter Enterprise*" (Tacit Knowledge Systems, Inc., © May 2001); http://www.forbes.com/global/2001/0205/088_print.html, as it appeared on 26 February 2001; McDonald, David W., "**Evaluating Expertise Recommendations**" – Proceedings of the 2001 International ACM SIGGROUP Conference on Supporting Group Work, in Boulder, Colorado, 2 October 2001, Pages 214-223; <http://www.tacit.com>, as it appeared on 7 December 2000; Kraenzel, U.S. Patent No. 6,513,039; and Cohen et al., U.S. Patent No. 6,377,983.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doug Hutton whose telephone number is (571) 272-4137. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

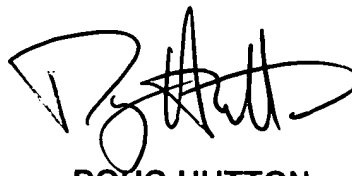
Application/Control Number: 10/044,922

Page 19

Art Unit: 2176

WDH

August 31, 2005

A handwritten signature in black ink, appearing to read 'Doug Hutton', with a large, stylized initial 'D'.

**DOUG HUTTON
PATENT EXAMINER
TECH CENTER 2100**